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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

In re Application of :
Masaharu Hayashi et al :
Serial No.: 09/842,896 : PETITION DECISION
Filed: April 27, 2001 :
Attorney Docket No.: 0425-0836P :

This is in response to applicants' petition under 37 CFR 1.181, filed November 26, 2002, requesting entry of an amendment filed after Final rejection.

A review of the file history shows that this application was filed April 27, 2001, and contained claims 1-9. On September 14, 2001, the examiner mailed a first Office action to applicants setting forth a restriction requirement in the form of an election of species based on the various compounds represented by formula I and formula II. Election of a single disclosed species was required. Applicants replied on October 15, 2001, with an appropriate election without traverse.

The examiner mailed a new Office action to applicants on December 17, 2001, setting forth a new restriction requirement as follows:

Group I, claims 1-3 and 6-9, drawn to an organic acid derivative plant activating agent;
Group II, claims 1, 4 and 6-9, drawn to a compound of formula II plant activating agent;
Group III, claims 1, 5 and 6-9, drawn to a glycerol derivative plant activating agent.

The examiner reasoned that the inventions were distinct on the basis of producing different effects. Applicants replied on January 17, 2002, electing Group II, with traverse, arguing that no burden is placed on the examiner to examine all three Groups.

The examiner mailed a first Office action on the merits to applicants on January 28, 2002, maintaining the restriction requirement on the basis that applicants' arguments were not persuasive. The examiner also rejected claim 9 under 35 U.S.C. 112, second paragraph, as indefinite for being a method of use but failing to recite any steps. Claim 9 was rejected under 35 U.S.C. 101 for the same reason. Claims 1, 4 and 6-9 were rejected under 35 U.S.C. 103(a) as unpatentable over Eibner et al.

Applicants replied on April 29, 2002, by amending portions of the specification and canceling claims 1-3, 5 and 9 and amending claims 4 and 6-8 and adding claims 10-18. Applicants argued the rejection of the claims over the Eibner et al reference, but did not further traverse the restriction requirement.

In the next Office action mailed to applicants on June 28, 2002, the examiner maintained the rejection under 35 U.S.C. 103(a) of claims 4 and 8 and added new claims 10-11, 13, 16 and 18 as unpatentable over Eibner et al as these claims include metal soaps and comprising language. Claims 6-7, 12, 14-15 and 17 were indicated allowable. Applicants replied on September 30, 2002, proposing amendments to claims 4, 8 and 10, which eliminated the language "counter ion" as a possible meaning for X in Formula I, and presented further arguments for patentability.

The examiner mailed an Advisory Action to applicants on November 4, 2002, denying entry of the amendment on the basis of new issues being raised and the explanation "Applicant only deletes metal soaps (fatty acid salts) from the instant invention. Further search will be required to examine other compounds being used in the instant invention."

Applicants' petition also indicates that a telephone interview was held with the examiner on October 29, 2002, but no examiner record of this interview can be found. During the interview, as reported in the petition, a proposed examiner's amendment to place the claims in condition for allowance was offered. The amendment would modify portions of the specification as well as amend claims 6, 10 and 15-18 (claims 6, 15 and 17 had previously been indicated as allowable) from "comprising" to "consisting essentially of" language. The examiner indicated that he knew of specific art which could be used to reject the claims as amended in the amendment filed September 30, 2002, but felt that the proposed amendments would adequately distinguish thereover.

DISCUSSION

Applicants' petition requests that the amendment filed September 30, 2002, be entered based on the argument that the amendments proposed therein avoid the rejection of record over Eibner et al. Applicants argue that the examiner's action in not entering the amendment was improper. As noted in the petition, Eibner et al is directed to a compound similar to applicants which contains a fertilizer compound and, *inter alia*, a metal soap (salt of a fatty acid). Applicants' claims are directed to a composition containing a "plant activating agent" and a surfactant or chelating agent or a fertilizer agent and to a method of activating a plant by applying the "plant activating agent". The plant activating agent is defined by formula (II):



where R is an alkyl or alkenyl group of 1-29 C atoms; AO is an oxyalkylene group (2-4C); n is from 0-30; and X¹ is hydrogen, alkyl or acyl group of 1-30 C atoms or alkenyl group of 2-30 C atoms, or a counter ion. The counter ion is defined in the specification as an alkali metal or

alkaline earth metal or alkylamine or alkanolamine salt. Thus when n is 0 and X^1 is a metal ion, a salt of a fatty acid is described. Such metal salts (metal soaps) are taught by Eibner et al as one of many "enveloping agents" which may be combined with a plant promoting agent, such as a fertilizer.

The examiner's rejection of the claims under 35 U.S.C. 103(a) focuses on Formula II being a metal salt. Applicants in the amendment after Final rejection eliminate such metal salts from the rejected method claims (but not the compound claims) in an effort to overcome the rejection based on one teaching of the Eibner et al reference.

It is axiomatic that an applicant may seek to amend pending rejected claims in such a manner as to avoid the teachings of a reference as applied by the examiner at any time during prosecution. By doing so applicants seek to advance prosecution of an application to allowance. Failure of an examiner to enter such an amendment, even after a Final Office action, on the basis that the narrowed claims would require further consideration or search appears to indicate that the examiner failed to completely examine all aspects of a claim, but examined only those that were readily taught by a reference(s). Compact prosecution requires an examiner to consider all aspects of an invention set forth in the pending claims as to their patentability, including all variations thereof. It appears that this has not occurred in this application.

Applicants report on an amendment proposed by the examiner which was not agreed to as it was based on uncited art apparently known to the examiner, but not of record in the application. The proposed amendment also appears to modify the scope of the disclosure, significantly narrowing it to only those compounds described for each component of the composition. Such an amendment is inappropriate as applicants disclosure is required to fully disclose the invention including variations and alternatives thereof and to limit it as proposed by the examiner si contrary to the provisions of 35 U.S.C. 112, first paragraph.

DECISION

Applicants' petition is **GRANTED**.

The amendment filed September 30, 2002, will be entered and fully considered by the examiner. If the amendment places the application in condition for allowance the examiner will issue an Office action to that effect. If one or more claims are not allowable in view of new prior art or a different application of previously applied prior art, the examiner will issue a new non-final Office action.

As Finality of the last Office action has not been withdrawn, Applicants remain under obligation to reply to the Final Office in an appropriate manner within the time period set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

Any request for reconsideration of this decision must be made within TWO MONTHS of the mailing date of this decision and should be addressed to the Office of Petitions.

John Doll 
Director, Technology Center 1600